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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 46320
	:	
Ronald DOYLE et al.	:	Confirmation Number: 1867
	:	
Application No.: 10/663,509	:	Group Art Unit: 3689
	:	
Filed: September 16, 2003	:	Examiner: D. Antonienko
	:	
For: ELECTRONIC RECEIPT MANAGEMENT	:	

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed July 28, 2009, wherein Appellants appeal from the Examiner's rejection of claims 1, 9, 13, and 17-28.

I. REAL PARTY IN INTEREST

This application is assigned to IBM Corporation by assignment recorded on September 16, 2003, at Reel 014508, Frame 0050.

II. RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 1, 9, 13, and 17-28 are pending and three-times rejected in this Application. Claims 2-8, 10-12, and 14-16 are cancelled. It is from the multiple rejections of the claims that this Appeal is taken.

IV. STATUS OF AMENDMENTS

The claims have not been amended subsequent to the imposition of the Third Office Action dated April 28, 2009 (hereinafter the Third Office Action).

V. SUMMARY OF CLAIMED SUBJECT MATTER

1 Referring to Figure 1 and also to independent claim 1, a receipt management article of
2 manufacture 100 is disclosed. The manufacture 100 includes a computer storage medium 120,
3 communications logic 170, 180, and a receipt management processor 110, 140 (lines 3-4 of
4 paragraph [0014]; lines 1-5 of paragraph [0015]). The computer storage medium 120 is
5 configured to store receipt data 130 from multiple disparate vendors 150A, 150B, 150N (lines 4-
6 5 of paragraph [0014]). The communications logic 170, 180 establishes a communicative link
7 between the system 100 and receipt data processing logic disposed within individual ones of the
8 multiple disparate vendors 150A, 150B, 150N (lines 1-11 of paragraph [0015]). The receipt
9 management processor 110, 140 is programmed to moderate access to the store receipt data 130
10 in the storage medium 120 to an individual one 150 of the multiple disparate vendors 150A,
11 150B, 150N (lines 5-9 of paragraph [0014]). The storage medium 120 further comprises a
12 configuration for indexing the store receipt data 130 according to at least one of a vendor
13 identifier and a transaction identifier (lines 1-8 of paragraph [0017]).

1 Referring to Figures 1 and 2 and also to independent claim 9, a method for electronic
2 receipt management is disclosed. In block 210, a communicative link is established between a
3 data store 120 of electronic receipts 130 from multiple disparate vendors 150A, 150B, 150N, and
4 an individual one of the multiple disparate vendors 150A, 150B, 150N (lines 4-6 of paragraph
5 [0016]). In block 220, the individual one 150 of the multiple disparate vendors 150A, 150B,
6 150N is authenticated (lines 6-8 of paragraph [0016]). In block 290, a specific electronic receipt
7 stored within the data store 130, which corresponds to an identifier provided by the individual
8 one 150 of the multiple disparate vendors 150A, 150B, 150N, is located (lines 1-6 of paragraph
9 [0018]). In blocks 300, 310, the located specific electronic receipt is transmitted to the
10 individual one 140 of the multiple disparate vendors 150A, 150B, 150N over the established
11 communicative link (lines 8-10 of paragraph [0018]).

12 Referring to Figures 1 and 2 and also to independent claim 13, a computer-readable
13 medium having stored thereon a computer-readable instructions for electronic receipt
14 management is disclosed. The computer-readable instructions causes a computer system to
15 perform the following steps. In block 210, a communicative link is established between a data
16 store 120 of electronic receipts 130 from multiple disparate vendors 150A, 150B, 150N, and an
17 individual one of the multiple disparate vendors 150A, 150B, 150N (lines 4-6 of paragraph
18 [0016]). In block 220, the individual one 150 of the multiple disparate vendors 150A, 150B,
19 150N is authenticated (lines 6-8 of paragraph [0016]). In block 290, a specific electronic receipt
20 stored within the data store 130, which corresponds to an identifier provided by the individual
21 one 150 of the multiple disparate vendors 150A, 150B, 150N, is located (lines 1-6 of paragraph
22 [0018]). In blocks 300, 310, the located specific electronic receipt is transmitted to the

- 1 individual one 140 of the multiple disparate vendors 150A, 150B, 150N over the established
- 2 communicative link (lines 8-10 of paragraph [0018]).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 9 and 23-25 were rejected under 35 U.S.C. § 101;
2. Claims 20 and 21 were rejected under the second paragraph of 35 U.S.C. § 112;
3. Claims 1, 17-18, and 20-21 were rejected under 35 U.S.C. § 102 for anticipation based upon Pitroda, U.S. Patent No. 5,884,271;
4. Claim 19 was rejected under 35 U.S.C. § 103 for obviousness based upon Pitroda;
5. Claim 22 was rejected under 35 U.S.C. § 103 for obviousness based upon Pitroda in view of Bam et al., U.S. Patent Publication No. 2004/0083170 (hereinafter Bam);
6. Claims 9, 13, 23, 24-26, and 28 were rejected under 35 U.S.C. § 103 for obviousness based upon Pitroda in view of Steele et al., U.S. Patent No. 7,016,877 (hereinafter Steele); and
7. Claims 24 and 27 were rejected under 35 U.S.C. § 103 for obviousness based upon Pitroda in view of Steele and Smith et al., U.S. Patent No. 6,487,540 (hereinafter Smith).

VII. ARGUMENT

THE REJECTION OF CLAIMS 9 AND 23-25 UNDER 35 U.S.C. § 101

For convenience of the Honorable Board in addressing the rejections, claims 23 and 25 stand or fall together with independent claim 9.

On page 3 of the Third Office Action, the Examiner newly rejected claims 9 and 23-25 under 35 U.S.C. § 101. The Examiner's only analysis regarding this rejection is reproduced below:

A method claim must meet a specialized, limited meaning to qualify as a patent-eligible process claim. With respect to being tied to another statutory class, a particular machine must impose meaningful limits on the method claim's scope. The machine must be positively recited in the body of the claim showing its significant function in the invention. Therefore, the language of independent Claim 9 does not include the required tie or transformation and thus is directed to nonstatutory subject matter. Claims 23-25 are dependent and are rejected in a like manner.

At the outset, Appellants note that the Examiner's analysis is entirely conclusory in nature. The Examiner does not refer to the language of the claims or explain why claim 9 does not allegedly "include the required tie or transformation."

Claim 9 recites "establishing a communicative link" and "transmitting said located specific electronic receipt ... over said established communicative link." Appellants' position is that the establishing of the communicative link and transmitting the electronic receipt over the communicative link necessarily ties the claimed method to electronic communication equipment (i.e., a particular type of device). Additionally, claim 9 recites that both the establishment of the link and the locating of the electronic receipt involves a data store, which is yet another particular type of device. Therefore, Appellants respectfully submit that the Examiner's

conclusory statement that claim 9 is not tied to a particular machine is in error. Thus, the Examiner has failed to properly establish that claim 9 is not directed to statutory subject matter.

THE REJECTION OF CLAIMS 20 AND 21 UNDER THE SECOND PARAGRAPH OF 35 U.S.C.

§ 112

For convenience of the Honorable Board in addressing the rejections, claims 20 and 21 each stand or fall alone.

On page 2 of the Third Office Action, the Examiner newly rejected claims 20 and 21 under the second paragraph of 35 U.S.C. § 112. The Examiner's only analysis regarding this rejection is reproduced below:

The claimed limitations of "a pervasive device" and "a personal article" are vague and indefinite.

Appellants respectfully submit that the Examiner has failed to establish a prima facie case of indefiniteness under the second paragraph of 35 U.S.C. § 112. M.P.E.P. § 2173.02 states the following:

If upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C. 112, second paragraph, is appropriate, such a rejection should be made and an analysis as to why the phrase(s) used in the claim is "vague and indefinite" should be included in the Office action. (emphasis added).

As stated in Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings,¹ "[o]nly when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite." The Examiner, however, has not established an interpretation of the claim in light of the specification or an interpretation of the claim as interpreted by one of ordinary skill in the art. Moreover, the Examiner has failed to set forth any

¹ 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004).

analysis as to why the limitation(s) in the claim does not reasonably define the invention. Thus, the Examiner has failed to establish a prima facie case of indefiniteness.

Claim 20

Although the Examiner alleged that the claimed "pervasive device" is vague and indefinite, paragraph [0007] of Appellants' disclosure provides several examples of a pervasive device. The claimed "pervasive device" is a term-of-art that would be recognized by one skilled in the art. In this regard, reference is made to the "Background of the Invention" section of U.S. Patent No. 6,925,481, which states the following:

Pervasive devices (also referred to as "pervasive computing devices") have become popular in recent years as people increasingly seek "anywhere, anytime" access to services such as voice and data communications. Many pervasive devices are designed to be mobile, and may equivalently be referred to as "mobile devices" or "mobile computing devices". Examples of mobile pervasive devices range from two-way pagers to personal digital assistants, or "PDAs" (such as the Palm Pilot, Handspring Visor.TM., or Compaq iPAQ) to cellular phones (such as the Nokia 6110) to multi-function devices (such as the Nokia 9110 or Qualcomm "pdQ.TM." smartphone). ("Visor" is a trademark of Handspring, and "pdQ" is a trademark of QUALCOMM Incorporated.) All pervasive devices are not necessarily mobile, however. Examples of this latter category include smart appliances for the home or business setting, devices which are permanently mounted in automobiles, and so forth.

Pervasive devices typically share several common characteristics:

- 1) limited processor speed;
- 2) limited memory capacity;
- 3) small size, which limits the richness of the data input and output interfaces (for example, small screen, limited keypad, and so forth);
- 4) a limited amount of software pre-installed on the device; and
- 5) access to limited-bandwidth networks.

Claim 21

Although the Examiner alleged that the claimed "personal article" is vague and indefinite, paragraph [0007] of Appellants' disclosure clearly describes an example of personal article (i.e., "[p]ersonal articles can items which are designed for close association with a person, such as a credit card device, a key chain fob, a purse, a wallet, and the like"). As such, Appellants'

1 position is that one skilled in the art would have no difficulty understanding the scope of the
2 phrase "personal article."

3
4 **THE REJECTION OF CLAIMS 1, 17-18, AND 20-21 UNDER 35 U.S.C. § 102 FOR**
5 **ANTICIPATION BASED UPON PITRODA**

6 For convenience of the Honorable Board in addressing the rejections, claims 17-18 and
7 20-21 stand or fall together with independent claim 1.

8
9 The factual determination of anticipation under 35 U.S.C. § 102 requires the identical
10 disclosure, either explicitly or inherently, of each element of a claimed invention in a single
11 reference.² Moreover, the anticipating prior art reference must describe the recited invention
12 with sufficient clarity and detail to establish that the claimed limitations existed in the prior art
13 and that such existence would be recognized by one having ordinary skill in the art.³

14
15 "Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The
16 first step in both analyses is a proper construction of the claims. ... The second step in the
17 analyses requires a comparison of the properly construed claim to the prior art."⁴ During patent
18 examination, the pending claims must be "given their broadest reasonable interpretation
19 consistent with the specification,"⁵ and the broadest reasonable interpretation of the claims must

² *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

³ See *In re Spada*, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

⁴ *Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).

⁵ *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

1 also be consistent with the interpretation that those skilled in the art would reach.⁶ Therefore, the
2 Examiner must (i) identify the individual elements of the claims and properly construe these
3 individual elements,⁷ and (ii) identify corresponding elements disclosed in the allegedly
4 anticipating reference and compare these allegedly corresponding elements to the individual
5 elements of the claims.⁸ This burden has not been met.

6
7 As previously argued in the Amendment filed June 28, 2008 (hereinafter the First
8 Response), Appellants recognize that Pitroda teaches a transaction memory area 410 that stores,
9 in electronic form, transaction receipts (see column 12, lines 21-24; column 10, lines 30-32;
10 column 11, lines 4-7, 24-26). Pitroda also describes that the transactions can be downloaded to a
11 home/office PC or stored in a main central computer of the card company (column 12, lines 24-
12 26; column 11, lines 7-9). However, with the exception of discussing that these transactions can
13 later be analyzed, Pitroda discusses little else with regard to the receipts.

14
15 Referring to claims 9 and 13, absent from the Examiner's cited passages are teachings
16 regarding (i) locating a specific electronic receipt stored within the data store which corresponds
17 to an identifier provided by the individual one of the multiple disparate vendors, and (ii)
18 transmitting the located specific electronic receipt to the individual one of the multiple disparate
19 vendors over the established communicative link. Also, although Pitroda teaches authenticating
20 the user of the UET card, the Examiner's cited passages fail to teach that the "individual one of

⁶ *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

⁷ See also, *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, . . . will normally control the remainder of the decisional process"); see *Gechter v. Davidson*, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

⁸ *Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

the multiple disparate vendors" is authenticated, as claimed. Claim 1 recites similar limitations to those found in claims 9 and 13 and is patentable over Pitroda for similar reasons to those presented above.

On pages 5 and 6 of the Second Office Action, the Examiner responded to Appellants' arguments presented in the First Response as follows. Initially, the Examiner asserted:

Regarding Claims 1, 9, and 13, Applicant argues that Pitroda does not teach (i) *locating a specific electronic receipt stored within the data store which corresponds to an identifier provided by the individual one of the multiple disparate vendors*. Examiner respectfully disagrees. Pitroda teaches storing all transaction receipts in electronic form and a database management system. Pitroda further teaches a POS (point of sale, i.e. vendor) database includes ID numbers, service numbers, or sales identifications (column 12, lines 21-32 and lines 60-67; Figure 2). A database by definition is a collection of data organized in such a way that facilitates access or retrieval of the data, among other things. Locating a specific piece of information in a database is inherent. Therefore, Examiner maintains that Pitroda does anticipate this limitation.

The Examiner's reliance upon the doctrine of inherency is misplaced. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency.⁹ To establish inherency, the extrinsic evidence must make clear that the missing element must necessarily be present in the thing described in the reference, and that the necessity of the feature's presence would be so recognized by persons of ordinary skill.¹⁰ Furthermore, reference is made to ex parte Schricker,¹¹ in which the Honorable Board of Patent Appeals and Interferences stated the following:

However, when an examiner relies on inherency, it is incumbent on the examiner to point to the "page and line" of the prior art which justifies an inherency theory. Compare, In re Rijckaert, 9 F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or

⁹ In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

¹⁰ Finnegan Corp. v. ITC, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); Continental Can Co. USA v. Monsanto Co., 20 USPQ 2d 1746 (Fed. Cir. 1991); Ex parte Levy, 17 USPQ2d 1461 (BPAI 1990).

¹¹ 56 USPQ2d 1723, 1725 (BPAI 2000).

suggestion appears in the prior art); In re Yates, 663 F.2d 1054, 107, 211 USPQ 1149, 1151 (CCPA 1981).

The Examiner did not discharge the burden of indicating where such a teaching appears in the prior art. As is readily apparent, the capability of "[l]ocating a specific piece of information in a database" is not necessarily limited to that claimed, as there are many different techniques that can be used to obtain information from a database. Thus, the Examiner has not established that this limitation is inherently disclosed by Pitroda. In this regard, the Examiner is also referred to M.P.E.P. § 2112, entitled "Requirements of Rejection Based on Inherency; Burden of Proof."

The Examiner's analysis also neglects to consider that the identifier is provided by the individual one of the multiple disparate vendors. Thus, even if the applied prior art uses an identifier to retrieve information, such a teaching alone would not establish that the Pitroda identically discloses all of the claimed limitations.

In the first full paragraph on page 6 of the Second Office Action, the Examiner further asserted the following:

Applicant argues that Pitroda does not teach *(ii) transmitting the located specific electronic receipt to the individual one of the multiple disparate vendors over the established communicative link*. Examiner respectfully disagrees. Pitroda teaches that after CIU software recognizes the UET card contact, the CIU prepares itself *to read information* from the UET card (column 13, lines 1-8; Figure 7). Figure 7 depicts the software for the CIU which explicitly teaches that the information read from the card has been transmitted from I/O drivers (71) to the UET card management (75) *CARD INFO. READ*. Therefore, Examiner maintains that Pitroda does anticipate this limitation.

Appellants recognize that the CIU software reads "information" from the UET card, but the Examiner has failed to establish that Pitroda teaches that an electronic receipt is transmitted to an

individual one of the multiple disparate vendors. To be anticipatory, the Examiner must establish that the applied prior art teaches all of the limitations, as claimed.

As discussed in column 14, lines 7-9 of Pitroda "security mechanisms can be built into the UET card to avoid access to confidential information." Thus, Pitroda explicitly recognizes that not all information found within the UET card should be accessible. Thus, the fact that Pitroda teaches that some information can be transmitted does not identically disclose that a particular type of information is transmitted.

In the last full paragraph on page 6 of the Second Office Action, the Examiner asserted the following:

Applicant argues that Pitroda fails to teach *that the "individual one of the multiple disparate vendors" is authenticated*. Examiner respectfully disagrees. Pitroda teaches *a previously authorized service institution* (column 7, lines 30-35). The step of authorizing a service institution or vendor or other business entity has been accomplished. The type of business entity authorized or authenticated does not alter the step of authenticating or the structure of the system. Therefore, such differences do not effectively serve to patentably distinguish the claimed invention over the prior art. Examiner maintains that Pitroda does anticipate this limitation.

The Examiner's citation of "a previously authorized service institution" found in column 7, lines 33-34 is a gross misrepresentation of the applied prior art. What Pitroda actually teaches is "selecting a previously authorized service institution account." By omitting the word "account" from the Examiner's characterization of the prior art, the Examiner has significantly misrepresented what Pitroda actually teaches. The authorization of an account is not the same as the authenticating a vendor.

The above-reproduced arguments (incorporated herein) were previously presented on page 6, line 14 through page 10, line 2 of the Amendment filed February 12, 2009 (hereinafter

1 the Second Response). Although Appellants did not add any limitations, by amendment, to
2 independent claim 1 in the Second Response, the Examiner did not directly respond to any of the
3 above-reproduced arguments. Upon comparing the statement of the rejection on pages 2 and 3
4 of the Second Office Action with the statement of the rejection on page 4 and 5 of the Third
5 Office Action, the only apparent differences is the Examiner's citation to column 12, line 21
6 through column 13, line 15 of Pitroda to teach the claimed "a receipt management processor
7 programmed to moderate access to said store receipt data in said storage medium to an individual
8 one of said multiple disparate vendors, wherein said storage medium further comprises a
9 configuration for indexing said store receipt data according to at least one of a vendor identifier
10 and a transaction identifier."

11
12 However, much of the Examiner's cited passage does not refer to the UET card (i.e., the
13 alleged receipt management article of manufacture). Instead, column 12, lines 45 through
14 column 13, line 15 of Pitroda refers to the hardware and software of the CIU, which is a separate
15 and distinct device from the UET card. Column 12, lines 33-36 refers to individual modules of
16 the UET card software, but none of these modules correspond to the claimed receipt
17 management processor. Column 12, lines 37-44 describes the general startup operation of the
18 UET card and is also silent as to the claimed receipt management processor. Therefore, the
19 Examiner's newly cited passages do not cure the previously-argued deficiencies in Pitroda.

20
21 **THE REJECTION OF CLAIM 19 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON**

22 **PITRODA**

23 For convenience of the Honorable Board in addressing the rejections, claim 19 stands or

falls together with independent claim 1.

Claim 19 depends from independent claim 1, and Appellants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 102 for anticipation based upon Pitroda. Accordingly, even if one having ordinary skill in the art were impelled to modify Pitroda, the claimed invention would not result. Appellants, therefore, respectfully submit that the imposed rejection of claim 19 under 35 U.S.C. § 103 for obviousness based upon Pitroda is not viable.

THE REJECTION OF CLAIM 22 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON PITRODA IN VIEW OF BAM

For convenience of the Honorable Board in addressing the rejections, claim 22 stands or falls together with independent claim 1.

Claim 22 depends from independent claim 1, and Appellants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 102 for anticipation based upon Pitroda. The secondary reference to Bam does not cure the argued deficiencies of Pitroda. Accordingly, even if one having ordinary skill in the art were impelled to combine the applied prior art, the claimed invention would not result. Appellants, therefore, respectfully submit that the imposed rejection of claim 22 under 35 U.S.C. § 103 for obviousness based upon Pitroda in view of Bam is not viable.

**THE REJECTION OF CLAIMS 9, 13, 23, 25-26, AND 28 UNDER 35 U.S.C. § 103 FOR
OBVIOUSNESS BASED UPON PITRODA IN VIEW OF STEELE**

For convenience of the Honorable Board in addressing the rejections, claims 13, 23, 25-26, and 28 stand or fall together with independent claim 9.

On October 10, 2007, the Patent Office issued the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*," 72 Fed. Reg. 57,526 (2007) (hereinafter the Examination Guidelines). Section III is entitled "Rationales To Support Rejections Under 35 U.S.C. 103." Within this section is the following quote from the Supreme Court: "rejections on obviousness grounds cannot be sustained by merely conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Referring to the first column on page 57,529 of the Examination Guidelines for Determining Obviousness, the following is a list of rationales that may be used to support a finding of obviousness under 35 U.S.C. § 103:

(A) Combining prior art elements according to known methods to yield predictable results;

(B) Simple substitution of one known element for another to obtain predictable results;

(C) Use of known technique to improve similar devices (methods, or products) in the same way;

(D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(E) "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Upon reviewing the Examiner's analysis on page 8 of the Third Office Action, the Examiner appears to be employing rationale (G). However, the Examiner's analysis is not entirely clear as to what rationale the Examiner is employing. As such, Appellants request that the Examiner clearly identify the rationale, as described in the Examination Guidelines for Determining Obviousness, being employed by the Examiner in rejecting the claims under 35 U.S.C. § 103.

Referring again to rationale (G), as discussed on page 57,534 of the Examination Guidelines, the following findings of fact must be articulated by the Examiner:

(1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;

(2) a finding that there was reasonable expectation of success; and

(3) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

Referring to the paragraph entitled "Office Personnel as Factfinders" on page 57,527 of the Examination guidelines, the following was stated:

Office personnel fulfill the critical role of factfinder when resolving the *Graham* inquiries. It must be remembered that while the ultimate determination of obviousness is a legal conclusion, the underlying *Graham* inquiries are factual. When making an obviousness rejection, Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. In certain circumstances, it may also be important to include explicit findings as to how a person of ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have known or could have done. Factual findings made by Office personnel are the necessary underpinnings to establish obviousness.

In Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court set forth the factual inquiries that are to be applied when establishing a background for determining obviousness under 35 U.S.C. 103. These factual inquiries are summarized as follows:

- (A) Determine the scope and content of the prior art;
- (B) Ascertain the differences between the prior art and the claims at issue;
- (C) Resolve the level of ordinary skill in the pertinent art; and
- (D) Evaluate any indicia of nonobviousness.

However, in order to make a proper comparison between the claimed invention and the prior art, the language of the claims must first be properly construed. See In re Paulsen, 30 F.3d 1475, 1479 (Fed. Cir. 1994). See also, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, ... will normally control the

remainder of the decisional process.") See Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

Upon reviewing the Examiner's analysis in view of the requirements discussed above necessary for the Examiner to establish a prima facie case of obviousness, Appellants recognize numerous deficiencies in the Examiner's analysis.

Referring to the paragraph spanning pages 7 and 8 of the Third Office Action, the Examiner presented the following analysis:

Pitroda does not explicitly teach locating a specific electronic receipt stored within said data store which corresponds to an identifier provided by said individual one of said multiple disparate vendors. However, Pitroda teaches *a transaction memory 410 is provided to store all transaction receipts in electronic form to eliminate or reduce paper receipts... database management 414... POS ID numbers... sales identifications* (column 12, lines 21-32 and lines 60-67; Figure 2). It is old and well-known that receipts have identification numbers given by the vendors as the vendors have their own accounting. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to locate receipts by vendor identifier in order to maintain consistency.

The Examiner's obviousness analysis is notable in that much of the analysis is unsupported by substantial evidence. Instead, the Examiner's analysis is relying upon speculation.

For example, the Examiner's assertion that "[i]t is old and well-known that receipts have identification numbers given by the vendors as the vendors have their own accounting" does not find support in either Pitroda or Steele. As such, this alleged finding of fact is based upon speculation and not substantial evidence.

Not only is the Examiner's assertion not based upon substantial evidence, the Examiner's

1 analysis falls short of establishing the obviousness of the claimed limitations. For example, even
2 *assuming arguendo* that the Examiner's assertion is based upon substantial evidence,
3 "identification numbers given by vendors as the vendors have their own accounting," do not
4 require that these same identification numbers be given to consumers since vendors may keep a
5 receipt of the transaction that differs from the receipt provided to the consumer.

6
7 Moreover, any numbers provided to a consumer by a vendor does not inherently identify
8 the vendor. For example, Vendor A and Vendor B, both with two stores, can use the identifiers
9 of "01" and "02" to identify their separate stores, and as such, these identifiers could not be used
10 to index store receipt data based upon a vendor identifier since the identifier does not identify the
11 vendor. Since there is no established requirement for different vendors to use different
12 identification numbers, one having ordinary skill in the art would recognize that, based upon the
13 teachings of the applied prior art, any identification numbers provided by a vendor does not
14 necessarily identify that vendor.

15
16 Therefore, not only has the Examiner has failed to rely upon substantial evidence in
17 alleging that is well known for vendors to use vendors identification numbers on the receipts
18 provided to customers, one having ordinary skill in the art would have recognized that, if these
19 identification numbers were provided, these identification numbers do not necessarily identify
20 the vendor. Thus, based upon the teachings of the applied prior art, it would not have been
21 obvious to one skilled in the art to perform the claimed step of "locating a specific electronic
22 receipt stored within said data store which corresponds to an identifier provided by said
23 individual one of said multiple disparate vendors."

Referring to the first full paragraph on page 8 of the Third Office Action, the Examiner presented the following analysis:

Pitroda does not explicitly teach transmitting said located specific electronic receipt to said individual one of said multiple disparate vendors over said established communicative link. However, Pitroda discloses that the CIU can read information from the UET card and that the *CIU unit may include an interface for a point of sale computer* (column 13, lines 1-16; Figure 7). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to transmit a receipt to the vendor if needed. (emphasis in original)

Although the Examiner asserts that it would have been obvious to transmit the receipt to the vendor "if needed," the Examiner has failed to (i) identify any teaching within the applied prior art that supports this finding or (ii) provide any analysis (supported by substantial evidence or not) that explains why one having ordinary skill in the art would, based upon the teachings of the applied prior art, transmit a receipt to the vendor. The vendor creates the receipt. As such, the question that has yet to be answered by the Examiner is why would one skilled in the art transmit a receipt to a vendor when the vendor has created the receipt and, thus, would already be in possession of the receipt.

Pitroda does not contemplate transmitting a receipt to the vendor. Referring to column 10, lines 30-32, Pitroda describes that the "POS computer also writes transaction information directly into the UET card thereby eliminating the need for paper receipts." Referring to column 10, lines 40-44, Pitroda describes that the "home PC 24 interfaces with the UET card to perform transactional analysis needed for tax review, summary, or budgeting purposes" and "[s]oftware for interfacing between the home PC and the UET card for reading information from the card is available." Thus, Pitroda explicitly describes the vendor writing information into the card and explicitly describes the home PC 24 reading information from the card. However, despite these

explicit descriptions, by Pitroda, as to the capabilities of various entities to read from or write onto the card, Pitroda is conspicuously silent as to the vendor reading information from the card (or data being transmitted from the card to the vendor, as claimed).

Referring to the second full paragraph on page 8 of the Third Office Action, the Examiner presented the following analysis:

Pitroda does not teach authenticating said individual one of said multiple disparate vendors. However, Steele discloses vendor authentication (column 16, line 46 — column 17, line 18). Pitroda teaches that the *UET card also includes security means... for preventing unauthorized access to the information stored in the memory means of the universal electronic transaction card (column 4, lines 10-14). Also, Pitroda teaches access to information stored in the card... can be blocked, unless the proper authorization code is entered* (column 14, lines 7-18). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Pitroda with that of Steele to include vendor authentication in order to prevent unauthorized access to the **stored information**. (emphasis in original)

Notwithstanding that the vendor authentication described by Steele is employed in a very different application than that claimed, one having ordinary skill in the art would not have been motivated to make this combination. The Examiner's alleged benefit for the modification is "to prevent unauthorized access to the stored information." However, as admitted by the Examiner, this benefit has already been provided by Pitroda, which employs an authorization code to block access to information stored in the card. Since the problem of preventing unauthorized access has already been solved by Pitroda, one having ordinary skill in the art would not have been realistically impelled to employ Steele to solve this problem. See Ex parte Rinkevich, Appeal 2007-1317 (non-precedential) ("we conclude that a person of ordinary skill in the art *having common sense* at the time of the invention would not have reasonably looked to Wu to solve a problem already solved by Savill") (emphasis in original).

1 **THE REJECTION OF CLAIMS 24 AND 27 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS**
2 **BASED UPON PITRODA IN VIEW OF STEELE AND SMITH**

3 For convenience of the Honorable Board in addressing the rejections, claims 24 and 27
4 stand or fall together with independent claim 9.

5
6 Claims 24 and 27 respectively depend from independent claims 9 and 13 and Appellants
7 incorporate herein the arguments previously advanced in traversing the imposed rejection of claims
8 9 and 13 under 35 U.S.C. § 103 for obviousness based upon Pitroda and Steele. The tertiary
9 reference to Smith does not cure the argued deficiencies of the prior rejection. Accordingly, even if
10 one having ordinary skill in the art were impelled to combine the applied prior art, the claimed
11 invention would not result. Appellants, therefore, respectfully submit that the imposed rejection
12 of claims 24 and 27 under 35 U.S.C. § 103 for obviousness based upon Pitroda in view of Steele
13 and Smith is not viable.

14
15 Conclusion

16 Based upon the foregoing, Appellants respectfully submit that the Examiner's rejections
17 under 35 U.S.C. §§ 101-103 and 112 is not viable. Appellants, therefore, respectfully solicit the
18 Honorable Board to reverse the Examiner's rejections under 35 U.S.C. §§ 101-103 and 112.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: September 28, 2009

Respectfully submitted,

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CUSTOMER NUMBER 46320

VIII. CLAIMS APPENDIX

1. A receipt management article of manufacture comprising:
 - a computer storage medium configured to store receipt data from multiple disparate vendors;
 - communications logic for establishing a communicative link between the system and receipt data processing logic disposed within individual ones of said multiple disparate vendors;
 - and
 - a receipt management processor programmed to moderate access to said store receipt data in said storage medium to an individual one of said multiple disparate vendors, wherein said storage medium further comprises a configuration for indexing said store receipt data according to at least one of a vendor identifier and a transaction identifier.

9. A method for electronic receipt management comprising the steps of:
 - establishing a communicative link between a data store of electronic receipts from multiple disparate vendors, and an individual one of said multiple disparate vendors;
 - authenticating said individual one of said multiple disparate vendors;
 - locating a specific electronic receipt stored within said data store which corresponds to an identifier provided by said individual one of said multiple disparate vendors; and,
 - transmitting said located specific electronic receipt to said individual one of said multiple disparate vendors over said established communicative link.

13. A computer-readable medium having stored thereon a computer-readable instructions for electronic receipt management, the computer -readable instructions for causing a computer system to perform the steps of:

establishing a communicative link between a data store of electronic receipts from multiple disparate vendors, and an individual one of said multiple disparate vendors;

authenticating said individual one of said multiple disparate vendors;

locating a specific electronic receipt stored within said data store which corresponds to an identifier provided by said individual one of said multiple disparate vendors; and,

transmitting said located specific electronic receipt to said individual one of said multiple disparate vendors over said established communicative link.

17. The article of manufacture of claim 1, wherein said storage medium comprises a portable mass storage device.

18. The article of manufacture of claim 1, wherein said communicative link comprises a wireless link.

19. The article of manufacture of claim 1, further comprising security and authentication logic programmed to secure access to said receipt data through at least one of encryption, password protection and certificate validation and authentication.

20. The article of manufacture of claim 1, wherein each of said storage medium, communications logic and receipt management processor is disposed in a pervasive device.

21. The article of manufacture of claim 1, wherein each of said storage medium, communications logic and receipt management processor is disposed in a personal article.

22. The article of manufacture of claim 1, wherein said personal article comprises a key chain fob.

23. The method of claim 9, wherein said establishing step comprises the step of configuring a wireless communications link with said individual one of said multiple disparate vendors.

24. The method of claim 9, wherein said establishing step comprises the step of configuring a wirebound communications link with said individual one of said multiple disparate vendors.

25. The method of claim 9, wherein said establishing step comprises the step of inserting a portable storage medium containing said data store into a reader coupled to said individual one of said multiple disparate vendors.

26. The machine readable storage of claim 13, wherein said establishing step comprises the step of configuring a wireless communications link with said individual one of said multiple disparate vendors.

27. The machine readable storage of claim 13, wherein said establishing step comprises the step of configuring a wirebound communications link with said individual one of said multiple disparate vendors.

28. The machine readable storage of claim 13, wherein said establishing step comprises the step of inserting a portable storage medium containing said data store into a reader coupled to said individual one of said multiple disparate vendors.

IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellants in this Appeal, and thus no evidence is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

Since Appellants are unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.